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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,101	08/17/2000	Bengt A. Carlson	835-007.3	6166

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EXAMINER
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KEASEL, ERIC S

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/641,101	CARLSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric Keasel	3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 28-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-22 and 28-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 17, 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the features canceled from the claims (no new matter should be entered into the drawings):

- i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42);
- ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42);
- iii) the insert member attached to the valve seat (claims 20, 31, and 38);
- iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
- v) the insert members made of plastic (claim 15);
- vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14);
- vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11);
- viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40); and
- ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claim 43 is objected to because the phrase "said insert member may is associated" is incorrect. Appropriate correction is required.

3. Claims 10-17, 19, 20, 22, and 28-45 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

- i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42);
- ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42);
- iii) the insert member attached to the valve seat (claims 20, 31, and 38);
- iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
- v) the insert members made of plastic (claim 15);
- vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14);

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vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11);

viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40); and

ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45).

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10-17, 19, 20, 22, and 28-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- i) the connector on the insert member (claims 10-17, 19, 20, 30-32, and 42);
- ii) the insert member attached to the valving member (claims 10-17, 19, 30, 32, and 42);
- iii) the insert member attached to the valve seat (claims 20, 31, and 38);
- iv) the insert member having a parabolic opening (claims 17, 22, 28-38, 41, and 42);
- v) the insert members made of plastic (claim 15);
- vi) the inserts having a diameter corresponding to the diameter of the bore of the valving member (claims 13 and 14);

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vii) the valving member and connectors of the insert members comprising cooperating legs and pockets (claim 11);

viii) a portion of the valve seat extending across the fluid passage and having an elongate opening (claims 39 and 40); and

ix) a connector on a periphery of the insert, the connector being adapted to position and secure the insert member across a passage through the valving member (claims 43-45).

6. Claims 18 and 21 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During prosecution of US Patent Application Number 09/084,698 (US Patent Number 6,039,304, the basis of the present reissue application), the following subject matter relating to the exact manner in which the insert disk is retained (attached) was introduced into independent

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claims 1, 15, and 22 in order to avoid art rejections and is subject matter that is surrendered (please note, the amendment to claims 1 and 15 was made in Paper No.10 and the amendment to claim 22 was made in Paper No. 13; claims 1, 15, and 22 were renumbered claims 1, 4, and 6 upon allowance):

“wherein at least one of the casing openings forms a groove” and “an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by the internal retaining ring which is at least partially recessed into the groove in one of the casing openings”

Appellants’ reissue claims 18 and 21 are rejected on the ground of improper recapture of subject matter surrendered during prosecution to avoid art rejections. Reissue claims 18 and 21 have broadened the limitations regarding the exact manner in which the disk insert is attached across the fluid passage by reciting that the inserts are merely “attachable across said fluid passage”. Since this broadened aspect of the claims relates to the surrendered subject matter, in that the exact manner of attachment was the same subject matter that was surrendered during prosecution of the original application (i.e. introduced because it was necessary to overcome the art rejections), and since recapture was not avoided (in the reissue claims) by addition of limitations relating to the specific aspect that was narrowed during prosecution (i.e. the exact manner of attachment), the broadening of the claims represents improper recapture.

7. Applicant's arguments filed with the appeal brief have been fully considered but they are not persuasive for the reasons set forth in the examiner's answer. Regarding newly added claims 43-45, the feature that the insert is attached across a passage through the valve member is not


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supported by the disclosure of Carlson et al. The insert of Marandi is attached across a passage through the valve member. The insert of Carlson et al. is attached outside the valve member across a passage going through the valve housing, not through the valve member.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 15 APR 2005  
Eric Keasel  
Primary Examiner  
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